

Appl. No. : 10/036,041  
Filed : December 26, 2001

### REMARKS

Upon entry of the amendments, Claims 22-26, 36 and 38-64 are pending as set forth above. Claims 36 and 38 have been amended as set forth above.

#### Compliance with 35 U.S.C. § 135(b)(2)

New Claims 52-64 have been added as set forth above. New Claim 52-64 have been modeled after claims in U.S. Patent Application Serial No. 10/321,164, filed on December 17, 2002, which was published on September 4, 2003 as Publication No. US 2003/0165530. New Claims 52-64 are added pursuant to 35 U.S.C. § 135(b)(2) ("A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an application published under section 122(b) of this title may be made in an application filed after the application is published only if the claim is made before 1 year after the date on which the application is published"). Thus, new claims have been added to avoid estoppels under § 135(b)(2), thereby preserving the ability to pursue such claims, for example, through interference proceedings.

Support for new Claims 52-64 is found in the application as filed. For example, new Claims 52-56 are supported, for example, by the claims as filed on by Figure 2 (showing C1q domain signature and domain proteins). Exemplary support for new Claims 57-58 is found in the specification at page 2 under paragraph 1, with the heading "PRO1484." Exemplary support for new Claim 59 is found in Figure 2. Support for new Claims 60-63, is found for example, in the specification at page 59. Exemplary support for new Claim 64 is found, for example, in the specification at page 63. No other claim amendments have been made and no new matter has been added.

#### Declaration

According to the Examiner, the Rule 1.131 Declaration submitted with the response filed on May 21, 2004 is sufficient to overcome U.S. Patent No. 6,521,233 ("the Piddington patent"), but is ineffective to overcome U.S. Publication No. US 2003/0165530 ("the Piddington application"). According to the Examiner, the Piddington application "*claims* the rejected invention." Therefore, according to the Examiner, "the reference can only be overcome by establishing priority of invention through interference proceedings."

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**Discussion of Rejections under 35 U.S.C. § 112, Second Paragraph**

Claim 36 is rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Particularly, the Examiner asserts that Claim 36 is indefinite and confusing for the recitation of "washes at 42°C in 0.2 x SSC and 50% formamide at 55°C." The Examiner states that it "is unclear how one wash can have two different temperatures, or separate washes with different temperatures are intended."

Claim 36 has been amended as set forth above to recite two steps, "a wash at 42°C in 0.2 x SSC (sodium chloride/sodium citrate)" and "a wash in 50% formamide at 55°C." In view of the amendment, Applicants request reconsideration and withdrawal of the rejection under § 112, second paragraph.

**Discussion of Rejections under 35 U.S.C. § 112, First Paragraph**

*Written Description*

Claim 36 remains rejected under 35 U.S.C. § 112, first paragraph, for containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. According to the Examiner, the previous amendment to include the specific stringent conditions was insufficient to satisfy the written description requirement because "the recited condition would not guarantee for obtaining the claimed species encoding a variant of SEQ ID NO:2 with the same functional activity, and the specification provides no working example of any of such variants that would fall within the limitations of the claims. As such, one of ordinary skill in the art would not know how to make a functional equivalent of SEQ ID NO:2" (*emphasis added*)

Claim 36 further has been amended to recite the functional limitation, "wherein said isolated nucleic acid encodes a polypeptide having the ability to induce chondrocyte redifferentiation." Accordingly, Applicants submit that the claimed genus having the recited function is fully described. Therefore, one of ordinary skill in the relevant art would recognize that Applicants possessed the claimed hybridization variants at the time the application was filed. Reconsideration and withdrawal of the instant written description rejection under § 112, first paragraph, is respectfully requested.

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**Discussion of Rejections under 35 U.S.C. § 102(e)**

Claims 22-26, 36 and 38-44 are rejected under 35 U.S.C. § 102(e) as being anticipated by Piddington et al., U.S. Publication No. US 2003/0165530, published September 4, 2003 (referred to hereafter as "the Piddington application"). According to the Office Action, some of the claims of the Piddington application claim the same invention as that in the instant application. Thus, according to the Examiner, "the reference can only be overcome by establishing priority of invention through interference proceedings."

Applicants thank the Examiner for her time and helpful attention on the telephone on Friday, September 03, 2004. Applicants also thank Interference Specialist Caputa for his time and suggestions regarding procedures related to initiating an interference. As discussed, Applicants desire to enter into an interference proceeding to determine rights to the claimed subject matter. Therefore, Applicants are in the process of preparing a Request for Interference with Patent under 37 C.F.R. § 1.604.

**Conclusion**

Applicants have endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. In particular, Applicants have endeavored to overcome the rejections under § 112, first and second paragraphs. In light of the above remarks, reconsideration and withdrawal of those outstanding rejections is specifically requested. Furthermore, Applicants have added new claims to avoid estoppels by complying with § 135(b)(2). Also, Applicants will submit the above-mentioned Request in order to further advance the case toward allowance by determining proper priority. If the Examiner finds any remaining issues that could be clarified with a telephone conference, the Examiner is respectfully requested to initiate the same with the undersigned.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 9/3/04

By: Marc T. Morley  
Marc T. Morley  
Registration No. 52,051  
Attorney of Record  
Customer No. 30,313  
(619) 235-8550

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